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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/654,941

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Ryuichi Sato

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EXAMINER

MORRISON, THOMAS A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/654,941	Applicant(s) SATO, RYUICHI	
	Examiner THOMAS A. MORRISON	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,220,592 (Watanabe et al.)(hereinafter “Watanabe et al.”).

Regarding claim 12, Figs. 1-62 of Watanabe et al. show a sheet processing apparatus (Fig. 1) comprising:

a compiling tray (12) for receiving and stacking sheets from a leading end side in a sheet-discharging direction, the sheets being conveyed through and discharged from a conveyance guide (16);

a longitudinal reference wall (33) for performing alignment of sheets stacked on the compiling tray (12) by aligning rear ends of the sheets, the longitudinal reference wall (33) being provided in a direction opposite to the sheet-discharging direction;

a first moving-aside unit (including 32) for moving the sheets aside toward the longitudinal reference wall (33) at a rear end side of the sheets supplied to the compiling tray (12); and

a second moving-aside unit (including 31 and 20) for moving the sheets aside toward the longitudinal reference wall (33) at a leading end side of each of the sheets, wherein the second moving-aside unit (including 31 and 20) is provided closer to the leading end side than the first moving-aside unit (32);

a part (31) contacting the sheets of the second moving-aside unit (including 31 and 20) moves between an upper position and a lower position (e.g., moves between upper and lower positions during rotation of element 31, as shown in Fig. 14);

a conveyance force of the second moving-aside unit (including 31 and 20) is used for moving the sheets aside toward the longitudinal reference wall (33), and set therein in such a way as to be variable;

the second moving-aside unit (including 31 and 20) **changes a first state into a second state having a weaker conveyance force than that of the first state so as to change the upper position and the lower position, when an amount of the sheets discharged from the leading end side of the sheets and stacked on the compiling tray exceeds a predetermined amount**; and

the second moving-aside unit (including 31 and 20) **changes the first state into the second state in an amount less than the predetermined amount when the sheets on which a folding is performed are discharged from the leading end side of the sheets and stacked on the compiling tray**.

Regarding the recitation “said second moving-aside unit **changes a first state into a second state having a weaker conveyance force than that of the first state**

so as to change the upper position and the lower position, when an amount of the sheets discharged from the leading end side of the sheets and stacked on the compiling tray exceeds a predetermined amount", the above-noted bolded portion of this recitation contains "conditional limitations" that need **not** ever occur. (emphasis added). For example, if an amount of the sheets discharged from the leading end side of the sheets and stacked on the compiling tray does **not** exceed the predetermined amount, the conditional limitations are **never** satisfied and there is **no** requirement for the second moving-aside unit to change from the first state to the second state as recited in claim 12. Since the above-noted bolded portion of this recitation contains conditional limitations that need **not** ever occur, this bolded portion of the recitation does not distinguish claim 12 from the prior art apparatus of Watanabe et al.

Regarding the recitation "said second moving-aside unit **changes the first state into the second state in an amount less than the predetermined amount when the sheets on which a folding is performed are discharged from the leading end side of the sheets and stacked on the compiling tray**", the above-noted bolded portion of this recitation contains "conditional limitations" that need **not** ever occur. (emphasis added). For example, if an amount of sheets discharged is less than the predetermined amount and **no folding** is performed on such sheets, the conditional limitations are **never** satisfied and there is **no** requirement for the second moving-aside unit to change from the first state to the second state as recited in claim 12. Since the above-noted bolded portion of this recitation contains conditional limitations that need **not** ever occur,

this bolded portion of the recitation does not distinguish claim 12 from the prior art apparatus of Watanabe et al.

In other words, if an amount of sheets discharged does **not** exceed the predetermined amount and this small amount of sheets that is discharged is **not** folded, **none** of the conditional limitations above are met and there is **no** requirement for the second moving aside unit to change at all. Thus, Watanabe et al. meets all of the limitations of claim 12 as now amended.

Regarding claim 13, Figs. 13-15 of Watanabe et al. show that the second moving-aside unit (including 31 and 20) is enabled to move in a direction of thickness of a sheet bundle accommodated in the compiling tray (12).

Regarding claim 14, Figs. 13-15 of Watanabe et al. show that the second moving-aside unit (including 31 and 20) changes a position thereof in a direction of thickness of a sheet bundle according to the sheet bundle stacked on the compiling tray (12). See also column 14, lines 12-21 of Watanabe et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of U.S. Patent No. 6,371,471 (Fukazu et al.).

Regarding claim 1, Figs. 1-62 of Watanabe et al. show a sheet processing apparatus (Fig. 1) comprising:

a compiling tray (12) for forming a sheet bundle by sequentially collecting sheets supplied thereto;

a sheet alignment portion (including 33) for aligning sheets supplied to the compiling tray (12); and

a pressing member (including 17b), provided in such a way as to be able to advance and retract in a direction of thickness of the sheets collected in the compiling tray (12), for holding sheets already collected in the compiling tray (12) and aligned in the sheet alignment portion (including 33) when a new sheet is supplied to the compiling tray (12); and

a controller that controls the pressing member (including 17b) according to a thickness of sheets collected on the compiling tray (12). See e.g., column 14, lines 14-30.

Moreover, the pressing member (including 17b) is provided in such a way as to advance and retract between an advancing position (Fig. 13), at which the pressing member (including 17b) presses sheets on the compiling tray (12), and a retreating position (Fig. 14) at which the pressing member (including 17b) does not hinder the sheets on the compiling tray (12) from being discharged therefrom.

Also, the pressing member (including 17b) is provided at a downstream side of a supplying direction of the sheets above the compiling tray (12).

Moreover, Figs. 1-62 of Watanabe et al. show a guide member (20), provided in such a way as to be able to be interlocked with the pressing member (including 17b), for guiding a sheet newly supplied to the compiling tray when the pressing member is moved to the advancing position.

More specifically, Figs. 1-62 of Watanabe et al. show a guide member (20), provided in such a way as to be able to be interlocked with the pressing member (including 17b). Moreover, in the recitation "a guide member, provided in such a way as to be able to be interlocked with said pressing member, **for guiding a sheet newly supplied to said compiling tray when said pressing member is moved to the advancing position**", the above-noted bolded portion of this recitation is a "statement of intended use". It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In addition, the Watanabe et al. patent discloses that papers are supplied to the Watanabe apparatus from an image forming apparatus. See e.g., column 1, lines 5-10. Moreover, Watanabe et al. discloses that advancing and retracting operations of the pressing member (including 17b) vary according to the thickness of the sheets on the compiling tray (12). See e.g., column 14, lines 14-30. However, Watanabe et al. does not specifically show that advancing and retracting operations of the pressing member

vary according to whether or not folding is performed on sheets newly supplied to the compiling tray, as claimed.

The Fukazu et al. patent discloses that it is well known to supply sheets to a sheet processing apparatus (500) from an image forming apparatus (300) via a folder (400), for the purpose of folding the sheets prior to supplying such sheets to the sheet processing apparatus (500). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Watanabe et al. apparatus on an image forming apparatus having a folder for the purpose of folding the sheets prior to supplying such sheets to the Watanabe et al. apparatus, as taught by Fukazu et al. Providing the Watanabe et al. apparatus on an image forming apparatus having a folder will result in folded sheets being supplied to the Watanabe et al. apparatus. Since the advancing and retracting operations of the pressing member (including 17b) vary according to the thickness of the sheets on the compiling tray (12) and folded sheets from the folder have a greater thickness than non-folded sheets, the advancing and retracting operations of the pressing member will vary according to whether or not folding is performed on sheets newly supplied to the compiling tray, as claimed. In other words, folding will result in thicker sheets added to the compiling tray (12), which will then cause the pressing member to operate based on these thicker sheets. Thus, all of the limitations of claim 1 are met.

Regarding claim 4, providing the Watanabe et al. apparatus on an image forming apparatus having a folder, in a manner as taught by Fukazu et al., will result in the advancing and retracting operations of the pressing member (including 17b) varying

according to what supply portions supply new sheets to the compiling tray (12). More specifically, the image forming apparatus can supply (1) thin non-folded sheets directly to the compiling tray (12) by bypassing the folding operation in the folder or (2) thick (i.e., folded) sheets from the image forming apparatus and the folder. Such thick or thin sheets will result in variation of the advancing and retracting operations of the pressing member (including 17b). Thus, all of the limitations of claim 4 are met.

Regarding claim 5, as best understood, Figs. 1-62 of Watanabe et al. show that the pressing member (including 17b) presses sheets already collected on the compiling tray (12) before a leading end of a sheet newly supplied to the compiling tray (12) touches the sheets already collected thereon, and wherein the pressing member (including 17b) goes away from the collected sheets before a rear end of the newly supplied sheet is discharged onto the compiling tray (12).

Response to Arguments

3. Applicant's arguments filed 6/13/2008 have been fully considered but they are not persuasive.

Applicant argues.

Newly amended independent claim 1 recites, in part, "advancing and retracting operations of said pressing member vary according to whether or not folding is performed on sheets newly supplied to said compiling tray; said pressing member is provided at a downstream side of a supplying direction of said sheets above said compiling tray, and a guide member, provided in such a way as to be able to be interlocked with said pressing member, for guiding the sheets newly supplied to said compiling tray when said pressing member is moved to the advancing position." Similarly, newly amended independent claim 12 recites, in part, "a conveyance force of said second moving-aside unit is used for moving said sheets aside toward said longitudinal reference wall, and set therein

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in such a way as to be variable; and said second moving-aside unit changes a first state into a second state having a weaker conveyance force than that of the first state so as to change the upper position and the lower position, when an amount of the sheets discharged from the leading end side of the sheets and stacked on the compiling tray exceeds a predetermined amount; and said second moving-aside unit changes the first state into the second state in an amount less than the predetermined amount when the sheets on which a folding is performed are discharged from the leading end side of the sheets and stacked on the compiling tray." *Watanabe or Fukazu*, whether taken alone or in combination, fail to teach or suggest at least these features of claims 1 and 12.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Watanabe and Fukazu*, whether taken alone or in combination, fail to teach or suggest each feature of newly amended independent claims 1 and 12, the rejection under 35 U.S.C. § 103 (a) should be withdrawn. Furthermore, claims 4-5 and 13-14 depend from one of independent claims 1 or 12. Accordingly, claims 4-5 and 13-14 are allowable because of the additional features they recite and the reasons stated above.

In response, *Watanabe et al.* in view of *Fukazu et al.* meets all of the limitations of the amended claims 1, 4 and 5, as explained in detail in the above rejections of these claims. Each of the limitations in these claims is explained above.

Applicant's arguments with respect to claims 12-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS A. MORRISON whose telephone number is (571)272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

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